

## **REMARKS**

### **I. Introduction**

Claims 21, 22, 24 to 30 and 32 to 44 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Objection to Specification**

The Office Action contends that “[t]he specification as originally filed does not provide antecedent basis for ‘a grate partially covering the opening.’” Office Action at page 2. Applicant has amended the claims to recite “a grate partially obstructing the opening.” Applicant respectfully maintains that this is fully supported by the specification as originally filed, as shown for instance in Figures 1 and 4, and the Examiner states in the Office Action that “[t]he grate ... clearly partially obstructs the opening.” Office Action at page 2.

### **III. Rejection of Claims 21, 22, 24 to 30 and 32 to 44 Under 35 U.S.C. §112**

Claims 21, 22, 24 to 30 and 32 to 44 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action contends that “[t]he original specification does not provide support for the grate ‘partially covering’ the opening.” Office Action at page 2. Applicant has amended claims 21, 30, 38 and 41 to recite “the grate partially obstructing the opening.” Applicant maintains that these amendments are fully supported by the original specification, as shown for instance in Figures 1 and 4, and the Examiner states in the Office Action that “[t]he grate ... clearly partially obstructs the opening.” Office Action at page 2.

### **IV. Rejection of Claims 41 and 43 Under 35 U.S.C. § 103(a)**

Claims 41 and 43 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,078,603 (“Cohen”) in view of U.S. Patent No. 5,015,184 (“Perry et al.”). Applicant respectfully submits that the combination of Cohen and Perry et al. does not anticipate the present claims for the following reasons.

Claim 41 relates to an oral airway. Claim 41 recites that the oral airway includes an elongate tubular member having a leading distal end and a proximal end. Claim 41 recites that the leading distal end leads the elongate tubular member as the elongate tubular member is inserted into the mouth and pharynx of the patient. Claim 41 recites that there is an opening at the leading distal end that is inclined, a posterior portion of the distal end extending beyond an anterior portion of the distal end. Claim 41 has been amended herein without prejudice to recite that the oral airway includes a grate partially obstructing the opening. Support for this amendment can be found, for instance, in Figures 1 and 4 which illustrate the grate partially obstructing the opening. Claim 41 also recites that the grate is configured so that as a patient's epiglottis is engaged by the grate during insertion of the distal end into the hypopharynx, the epiglottis slides along the grate and into abutment with an anterior portion of the elongate tubular member.

Cohen purports to disclose a filtering suction nozzle particularly adapted for use in connection with a dental or medical suction system. Chen states that the nozzle is suited for use as a high speed suction tip and/or a saliva ejector formed of an elongate tube defining a fluid flow path therethrough. According to Cohen, filtering means are arranged within the tube in the flow path of any fluid passing therethrough, and coupling means are arranged at one end of the tube to connect the tube to a suction line from a suction source. Cohen states that the tube may be formed with flexible pleats to facilitate bending. According to the method described by Cohen, filtering means are arranged in the flow path of any existing suction nozzles to thereby reduce debris collection in the suction system and minimize possible patient infection from previously collected debris. Abstract.

Perry et al. purport to relate to a dental saliva ejector tube and/or high volume evacuator tube guard having an annular ring segment for frictional and releasable attachment to the open, free end of the ejector tube or as an integral part of a suction tube, either flexible or rigid. Perry et al. state that the tube guard includes a pair of symmetrical guard loops lying in spaced, parallel planes each having two opposite ends which integrally extend from the annular ring segment and taper inwardly toward the central axis of the annular ring segment in a direction away from the ejector tube. According to Perry et al., the symmetrical guards have substantially straight segments extending between the distal end of the guards and the annular ring segment, forming an acute inner angle with the central axis of the ring segment. Perry et al. state that a third guard loop lying in a plane substantially

perpendicular to the spaced, parallel planes integrally extends from the annular ring segment and loops over the symmetrical guard loops to form a cage-like structure wherein saliva and matter may be easily drawn into the ejector tube through the openings between the guard loops, the guard loops substantially preventing the soft tissues of the inside of the mouth from being drawn in therebetween. Abstract.

The Final Office Action states that "it would have been obvious to have placed or formed the grate of Perry [et al.] on the distal end of a tube such as that disclosed by Cohen, as this would prevent tissue from entering and clogging the distal port or opening." Office Action at pages 3-4. The Office Action also states that "[a]lternatively, it would have been obvious to have cut the end of the tube 12 disclosed by Perry [et al.] at an incline, as taught by Cohen, as this provides a larger open area for materials or fluid to be aspirated into the tube's distal end without clogging the end." Office Action at page 4.

It is respectfully submitted that the combination of Cohen and Perry et al. does not render obvious claims 41 and 43 for at least the reason that the combination of Cohen and Perry et al. does not disclose, or even suggest, all of the features recited in claims 41 and 43: For example, the combination of Cohen and Perry et al. fails to disclose, or even suggest, an oral airway that includes a grate partially obstructing the opening, the grate configured so that as a patient's epiglottis is engaged by the grate during insertion of the distal end into the hypopharynx, the epiglottis slides along the grate and into abutment with an anterior portion of the elongate tubular member.

In contrast, Cohen and Perry et al. relate to dental suction implements for evacuating saliva from a patient. There is no disclosure whatsoever in either Cohen or Perry et al. that the dental suction implements of Cohen and Perry et al. are inserted into the pharynx of a patient. Furthermore, there is no disclosure whatsoever in either Cohen or Perry et al. that the dental suction implements of Cohen and Perry et al. are configured to engage a patient's epiglottis. Rather, Cohen describes that its dental suction implement is "shaped to follow the contours across the lip and in the mouth of a patient so as to permit positioning over the lower lip." Column 3, lines 16 to 19. Thus, the distal end 12 of the tube 10 in Cohen never engages a patient's epiglottis. Also, Perry et al. describes that "[t]his invention relates to relates to guards for affixing to the free, open end of a suction tube and, more particularly, to a guard for the open end of suction tubes and high volume evacuators used for ejecting saliva and matter from a patient's mouth during dental

procedures,” col. 1, lines 6 to 10, and “guard 10 is inserted into the mouth of the patient, lightly contacting segments 26 and 28 with the lining of the mouth where excessive saliva and matter has accumulated, typically under or beside the tongue and in the trough formed by dental ridge and the cheek.” Col. 4, lines 3 to 7. Thus, the distal end of the tube 12 in Perry et al. never engages a patient’s epiglottis.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As more fully set forth above, it is respectfully submitted that the combination of Cohen and Perry et al. does not disclose, or even suggest, all of the features recited in claim 41.

In summary, it is respectfully submitted that the combination of Cohen and Perry et al. does not render unpatentable claim 41. As for claim 26, which depends from claim 41 and therefore includes all of the limitations of claim 41, it is respectfully submitted that the combination of Cohen and Perry et al. does not render unpatentable this dependent claim for at least the same reasons given above in support of the patentability of claim 41.

## **V. Request For Interference**

Applicants respectfully request that, since it is believed that all of the pending claims of the present application are now in condition for allowance, an interference be declared between claims 21, 22, 24 to 30 and 32 to 44 of the present application and claims 1 to 39 of U.S. Patent No. 6,386,199 (“the ‘199 patent”), for the reasons set forth in Applicant’s previously filed “Amendment and Request for Interference” filed in the U.S. Patent and Trademark Office on May 13, 2003 and additionally for the reasons set forth below.

As set forth above, Applicant has amended claims 21, 30, 38 and 41 to recite “the grate partially obstructing the opening.” The Specification states at page 17, lines 27 to 33 that “[t]he bars and grates 143 act to restrain any anatomical portion ... from entering into and blocking or partially blocking, the mask opening 111’, thereby preventing obstruction of the delivery or removal of gases from the respiratory system of the patient P.”

Claims 1, 18, 30 and 35 of the ‘199 patent recite “a grate covering the opening.” The ‘199 patent states that “FIG. 7A further includes a plurality of bars 452 forming a grate over the leading opening 454 [wherein] the bars are rigid enough to support the epiglottis.” Column 10, lines 43 to 50. In addition, the ‘199 patent states that “a grate may cover the opening to keep the epiglottis and other tissue out of the opening.” Column 5, lines 29 to 30, emphasis added.

Applicant therefore respectfully maintains that, by virtue of the fact that the gratings of the present application and the ‘199 patent perform the same function and in the context of the claims are directed to the same patentable invention, an interference should be declared between claims 21, 22, 24 to 30 and 32 to 44 of the present application -- which include the limitation of “[a] grate partially obstructing the opening” -- and claims 1 to 39 of the ‘199 patent -- which include the limitation of “[a] grate covering the opening.”

## **VI. Conclusion**

Applicants respectfully submit that all of the pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application, and the declaration of the above-referenced interference proceeding, are therefore earnestly solicited.

**VII. Fees**

The Commissioner is authorized to charge any necessary fees or credit any overpayments under 37 C.F.R. §§ 1.16 and 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON

Dated: October 25, 2004

By: 

Thomas C. Hughes  
Reg. No. 42,674

One Broadway  
New York, New York 10004  
(212) 425-7200